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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,797	02/05/2004	Felice DiMascio	HAT-0020-P	8450
23413	7590	09/26/2007		
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER WILKINS III, HARRY D	
			ART UNIT 1753	PAPER NUMBER
			MAIL DATE 09/26/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/773,797

Applicant(s)

DIMASCIO, FELICE

Examiner

Harry D. Wilkins, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-34 is/are rejected.
- 7) ☒ Claim(s) 30-34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-19, drawn to a process of making chlorine dioxide, classified in class 205, subclass 556.
  - II. Claims 20-34, drawn to a system for making chlorine dioxide, classified in class 204, subclass 263.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by a materially different apparatus, which does not involve a partially filled vessel and a cartridge containing a solid phase chlorine-containing material, such as a vessel with an open top into which the solid phase chlorine-containing material is added.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. It is noted that group II, claims 20-34, include two distinct species. This application contains claims directed to the following patentably distinct species: (a)

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parallel generation of streams fed to a mixer (claim 20) and (b) series generation of streams (claim 27). The species are independent or distinct because they operate in a different manner and are mutually exclusive of each other.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. During a telephone conversation with Peter Hagerty on 20 March 2007 a provisional election was made with traverse to prosecute the invention of group I, species (b), claims 27-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Objections***

7. Claims 30-34 are objected to because of the following informalities: each of these claims recite "The process according to claim 27...". Claim 27 is a system. Claims 30-34 will be assumed to read "The system according to claim 27" for purposes of examination. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imrie et al (GB 2,263,108) in view of Lipsztajn et al (US 6,203,688) with reference to Kaczur et al (US 5,106,465, incorporated by reference into Lipsztajn et al) and Buchan (US 6,413,416).

Imrie et al. discloses an apparatus for generating chlorine dioxide comprising:

-a vessel comprising a housing (i.e., a vessel such as a tower; see page 2, last paragraph), inherently comprising an inlet and an outlet (i.e., the vessel is provided with

means to allow the flow therethrough of an aqueous medium; see page 2, last paragraph).

-a solid phase chlorine containing material is disposed within the housing (i.e., an active halogen source comprising a source of chlorine, in the form of tablets that are packed into the vessel or tower; see page 2, paragraphs 3-6 and last paragraph).

The apparatus generates chlorine dioxide by passing an aqueous solution of a metal chlorite, such as sodium chlorite, through the vessel containing the solid phase chlorine containing material (see page 1, last paragraph; see also page 3, paragraphs 1-3).

In addition, Imrie et al. discloses that the reaction preferably occurs under acid-to-neutral conditions (see page 3, fourth paragraph).

Imrie et al., however, is silent as to the apparatus comprising the instantly claimed means for supplying water and a chlorite ion to the vessel (i.e., for forming the aqueous solution of a metal chlorite), and the instantly claimed means for supplying an acid to the vessel (i.e., for forming the acid-to-neutral reaction conditions).

Lipsztajn et al teach (see col. 3, line 18 to col. 5, line 43 and col. 9, lines 53-67) describes the electrochemical acidification of sodium chlorite solutions. Lipsztajn et al teach that commercially available sodium chlorite solutions were adjusted to be alkaline in pH to prevent decomposition into chlorine dioxide, and thus, needed to be acidified to achieve a neutral/acidic pH. Lipsztajn et al teach using a three-compartment electrolytic cell, such as that disclosed by Kaczur et al, for the production of the acidified sodium chlorite solution. The three-compartment cell was arranged as shown in figure

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2 of Lipsztajn et al, and included water feeds to the anode and cathode compartments and the sodium chlorite solution being fed to the central compartment. Although Lipsztajn et al fail to teach cation exchange resins being disposed in the central compartment, Kaczur et al teach (see figure 1, col. 3, lines 38-47 and col. 5, line 66 to col 6, line 43) that cation exchange resin beads/rods/fibers can be placed within the central compartment for the purpose of reducing operating voltage when dealing with more dilute chlorite solutions.

Therefore, it would have been obvious to one of ordinary skill in the art to have utilized the structure shown by the Lipsztajn et al for production of the acidified chlorite solution required by Imrie et al because the electrochemical acidification cell of Lipstajn et al was able to achieve good results in acidifying sodium chlorite solutions.

Thus, Imrie et al fail to teach that the vessel included a cartridge having a lower portion with openings in fluid communication with the water (inside the vessel).

Buchan teach (see abstract and figures 1-5) a water treatment vessel for dissolving tablets of material into water, wherein the tablets are stored within a cartridge. The apparatus achieves balancing of inflow and outflow of water and prevents overflow or a drop in water level by inclusion of a float valve.

Thus, it would have been obvious to one of ordinary skill in the art to have substituted the dissolver of Buchan for the tower of Imrie et al because the dissolver of Buchan included means for making sure that the water was in constant contact with the solid phase chlorine-containing material.

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Regarding claim 28, Kaczur et al teach (see col. 5, line 67 to col 6, line 6) using cation exchange resins having backbones of polystyrene based with divinylbenzene.

Regarding claim 29, Imrie et al teach (see page 2, paragraphs 4-6) using a solid phase chlorine-containing material such as sodium dichloro-isocyanurate or trichloroisocyanuric acid.

Regarding claim 30, the modified apparatus of Imrie et al. structurally meets the claims, because the particular pH level is considered a process limitation that adds no further patentable weight to the apparatus claim. In any event, it is noted that Lipsztajn et al further teaches that the pH of the solution leaving the electrochemical acidification cell was within the range of 2 to 7 (see col. 4, lines 16-23). Furthermore, the specific pH level is not considered to confer patentability to the claim since the precise pH would have been considered a result effective variable by one having ordinary skill in the art. Also, it is noted that the present specification sets forth in section [0031] that the claimed pH level, is at best, a preferred limitation. As such, without more, the claimed ratio cannot be considered "critical". Accordingly, one having ordinary skill in the art would have routinely optimized the pH level of the water source in the system to obtain the desired level of chlorine dioxide generation, *In re Boesch*, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980), and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art, *In re Aller*, 105 USPQ 233.



Regarding claim 31, Buchan teaches using a float valve to control the water level within the dissolver vessel to prevent overflow and to ensure that the solid phase chlorine-containing material was always in contact with water.

Regarding claim 32, since the prior art teaches using the same material as the solid phase chlorine-containing material as is disclosed for use by the present application, the prior art is considered to inherently possess the claims solubility limit.

Regarding claim 33, it would have been within the expected skill of a routineer in the art to have optimized the amount of contact between the water and the solid phase chlorine-containing material in order to optimize the amount of chlorine dioxide produced within the vessel.

Regarding claim 34, since Imrie et al fail to teach any heating or cooling means in the apparatus, one of ordinary skill in the art would have considered the process to inherently occur at approximately room temperature (~23°C). Further, Kaczur et al teach (see col. 5, lines 14-20) that care needs to be taken to ensure that the temperature of solutions containing chlorine dioxide not reach too high a level to avoid safety issues related with chlorine dioxide vapor. Thus, one of ordinary skill in the art would have been led to keep the temperature below such limit, such as 70°C.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 27-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 23-26 and 28-47 of copending Application No. 10/683,056 in view of Buchan (US 6,413,416). The feature of a cartridge is missing from the claims of the '056 application. However, as shown above, such features were known to one of ordinary skill in the art in the dissolver of Buchan. Buchan teaches certain advantages to using the dissolver, such as maintaining a constant level of water in the dissolver.

This is a provisional obviousness-type double patenting rejection.

### **Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry D. Wilkins, III whose telephone number is 571-272-1251. The examiner can normally be reached on M-F 7:45am-4:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susy Tsang-Foster can be reached on 571-272-1293. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Harry D Wilkins, III  
Primary Examiner  
Art Unit 1753

hdw